

## **REMARKS**

### **Status of the Claims**

The Office Action dated May 21, 2004 has been received and its contents carefully considered. Claims 1-20 are pending. Claims 1-20 have been rejected. Claims 1, 8 and 15 have been amended. Claim 21 has been added.

Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

### **Office Action**

The drawings were objected to under 37 C.F.R. §1.83(a). An amendment to Figure 1 is attached which depicts a fiber optic cable 20 encased in a flexible arm 21. Support for the claim flexible arm can be found in applicant's specification on page 5, line 20 - page 6, line 1. No new matter has been added. It is believed that the amendment to the drawing is in compliance.

Claims 1-3 and 5-6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Danna, *et al.* in view of Sakamoto, *et al.* Without conceding the propriety of the rejection, independent claim 1 has been amended. It is respectfully submitted that Danna, *et al.* does not teach, *inter alia*, a flexible viewing scope apparatus comprising "an eyepiece having an eyepiece lens connected to said source of ultraviolet light, wherein the eyepiece has a free end" in combination with the rest of the claimed features as recited in claim 1.

The Examiner concedes that Danna *et al.* does not teach-an eyepiece having an eyepiece lens. The Examiner turns to Sakamoto, *et al.*, which depicts an eyepiece portion 162 and an eyepiece lens system 164 having an image-sensing lens 174 in combination with a TV camera 172, all of which can be further connected to a video processor 146 and TV monitor 23, as

depicted, for instance, in FIG. 26. However, Sakamoto, *et al.* does not cure the deficiencies of Dana, *et al.*, because the eyepiece does not have a free end as recited in Claim 1 of the present invention. By locating the eyepiece and the light source at the second end of the fiber optic cable, a compact handheld device is provided so that light will be delivered to objects and hidden locations, *e.g.*, objects located around, behind, above, inside, etc., other objects, and allow leaks to be viewed in tight spaces without having to dismantle portions of the equipment (see paragraphs 5-9 of the present application.)

In accordance with the M.P.E.P. §2143.03, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re: Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re: Wilson*, 424 F.2d 382, 1385, 165 USPQ 494 196 (CCPA 1970). Therefore, since the prior art lacks all of claim features, Danna, *et al.*, alone or in combination with Sakamoto, *et al.*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 2-3 and 5-6 ultimately depend from independent claim 1 and are patentable over the cited prior art, for at least the same reasons as is Claim 1.

Claims 4 and 7 were rejected under 35 U.S.C. §103(a) as being unpatentable over Danna, *et al.*, in view of Sakamoto, *et al.*, and further in view of Tomasch. Claims 4 and 7 ultimately depend from independent claim 1. Without conceding the propriety of the rejection, independent claim 1 has been amended. As outlined above, it is respectfully submitted that Danna, *et al.* does not teach, *inter alia*, a flexible viewing scope apparatus comprising “an eyepiece having an eyepiece lens connected to said source of ultraviolet light, wherein the eyepiece has a free end”

in combination with the other claimed features as recited in claim 1. Sakamoto, *et al.*, does not cure the deficiencies of Danna, *et al.* as presented above. Furthermore, Tomasch does not cure the deficiencies of Danna, *et al.*, in view of Sakamoto, *et al.*, because, it, too, does not teach the structural features including the eyepiece having an eyepiece lens connected to the source of ultraviolet light wherein the eyepiece has a free end. Therefore, since the prior art lacks all of the claimed features, Danna, *et al.*, alone or in combination with Sakamoto, *et al.*, and Tomasch, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 8-11 and 15-18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tomasch in view of Sakamoto, *et al.* Without conceding the propriety of the rejection, independent claims 8 and 15 have been amended. It is respectfully submitted that Tomasch does not teach, *inter alia*, a method of leak detection comprising the steps of “providing an eyepiece having an eyepiece lens connected to a source of ultraviolet light, wherein the eyepiece has a free end and the ultraviolet light source is connected to an end of a fiber-optic cable” in combination with the rest of the claimed features as recited in claim 8. It is also respectfully submitted that Tomasch does not teach, *inter alia*., a flexible viewing scope apparatus comprising “an eyepiece having an eyepiece lens connected to the illuminating means, wherein the eyepiece has a free end and the illuminating means is connected to an end of a fiber optic cable” in combination with the rest of the claimed features as recited in claim 15.

The Examiner concedes that Tomasch does not teach an eyepiece having an eyepiece lens. Sakamoto, *et al.* does not cure the deficiencies of Tomasch because, as presented above, the eyepiece of Sakamoto, *et al.*, does not have a free end as recited in claims 8 and 15.

Sakamoto teaches away from the invention as claimed because the structural setup of the bore

scope apparatus includes a TV camera 172 attached to the eyepiece portion as shown for instance in FIG. 26 (see also Sakamoto, *et al.*, Column 14, lines 4-37). Therefore, since the prior art lacks all of the claimed features, Tomasch, alone or in combination with Sakamoto *et al.*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

Claims 9-11 ultimately depend from independent claim 8 and are patentable with cited prior art for at least the same reasons as is claim 8.

Claims 16-18 ultimately depend from independent claim 15 and are patentable over the cited prior art for at least the same reasons as is claim 15.

Claims 12-14 and 19-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Tomasch in view of Sakamoto, *et al.* and further in view of Danna, *et al.* Claims 12-14 ultimately depend from independent claim 8. Without conceding the propriety of the rejection, independent claim 8 has been amended. It is respectfully submitted that Tomasch does not teach the invention as recited in claim 8 as presented above. Furthermore, it is respectfully submitted that Sakamoto, *et al.* fails to cure the deficiencies of Tomasch as presented above. Danna, *et al.*, fails to cure the deficiencies of Tomasch in view of Sakamoto, *et al.* because, it too, fails to teach a method of leak detection comprising the steps of “providing an eyepiece having an eyepiece lens connected to a source of ultraviolet light, wherein the eyepiece has a free end and the ultraviolet light source is connected to an end of a fiber optic cable” in combination with the rest of the claimed features as recited in claim 8.

Claims 19-20 ultimately depend from independent claim 15. Without conceding the propriety of the rejection, independent claim 15 has been amended. It is respectfully submitted that Tomasch does not teach the invention as recited in claim 15 as presented above. It is further

respectfully submitted that Sakamoto, *et al.*, does not cure the deficiencies of Tomasch as outlined above. Furthermore, Danna, *et al.* does not cure the deficiencies of Tomasch in view of Sakamoto, *et al.* because, it too, fails to teach a flexible viewing scope apparatus comprising “an eyepiece having an eyepiece lens connected to the illuminating means, wherein the eyepiece has a free end and the illuminating means is connected to an end of a fiber optic cable” in combination with the rest of the claimed features as recited in claim 15. Therefore, since the prior art lacks the prior art lacks all of the claimed features, Tomasch, alone or in combination with Sakamoto, *et al.*, and Danna, *et al.*, cannot be said to teach or suggest the present invention as claimed. Hence, withdrawal of the rejection is respectfully requested.

In view of the foregoing, reconsideration and allowance of the application are believed in order and such action is earnestly solicited.

Should the Examiner believe that a telephone conference would expedite issuance of the application, the Examiner is respectfully invited to telephone the undersigned Patent Agent at 202-861-1538.

Respectfully submitted,

BAKER & HOSTETLER LLP

A handwritten signature in black ink, appearing to read 'Marc W. Butler', with a large, stylized flourish extending to the right.

Marc W. Butler  
Reg. No. 50,219

Attachment:  
Appendix 1

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